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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,291	02/16/2006	Toshiya Kaihoko	286324US6PCT	3481

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
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ALEXANDRIA, VA 22314

EXAMINER

ZHAO, DAQUAN

ART UNIT	PAPER NUMBER
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2621

NOTIFICATION DATE	DELIVERY MODE
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01/08/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/568,291	Applicant(s) KAIHOKO ET AL.	
	Examiner DAQUAN ZHAO	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/13/2008; 2/16/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Page 3 of the specification contains URL: <http://www.sony.co.jp/Products/Hi-MD/>

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2 and 4-5 are rejected under 35 U.S.C. 101 because claims are directed to non-statutory subject matter.

For claim 2, "In the start of the art, transitory signals are commonplace as a medium for transmitting computer instruction and thus, in the absence of any evidence to the contrary and give the broadest reasonable interpretation, the scope of a "computer readable medium" covers a signal per se." In order to overcome the 35 U.S.C. 101 rejection, the "recording medium" should be changed to "non-transitory recording medium".

Claims 4-5 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S.

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175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al (US 7,305,170 B2) and further in view of Hyodo et al (US 6,021,250).

For claim 2, Okada et al teach a recording medium in which encoded content information is to be recorded, the recording medium including:

a data area in which the content information is recorded in units of an access block each including a succession of frames (e.g. figures 2 and 8, column 9, lines 5-13 and column 5, lines 24-30, MPEG video data contains I-frame, B-frame and P-frame are recorded in the unit of sector in the DVD); and

a management area in which management information for the content information is to be recorded (e.g. abstract, figure 16, column 12, lines 20-23, figure 16 shows a ACCESS MAP is recorded in the VIDEO MANAGEMENT INFORMATION (VIDEO MANAGER)),

the leading one of the frames of each access block being taken as the base point of decoding (e.g. figure 24, column 22, lines 8-21, each block entries is begins with I-picture because each GOP in MPEG begins with the I-picture);

the management area having recorded therein the recording-position information for each access block and output-time information for the leading block of each access block (e.g. abstract, column 12, lines 20-31 and figure 22A, column 19, line 41- column 20, line 7, PTS stands for Presentation Time Stamp, which indicates the time the picture is presented or output, “an index value to the block number of the block in which the I-picture is stored” corresponds to the recording-position information);

However, Okada et al fail to teach the data area having information other than the leading one along with each access block. Hyodo et al teach the data area having information for the frames other than the leading one along with each access block (e.g. figure 18, memory for P-type key frame table 34, and figure 20b shows the start sector number of P-key frame). It would have been obvious to one ordinary skill in the art at

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the time the invention to incorporate the teaching of Hyodo et al into the teaching of Okada et al to recorded therein the recording-position information for frames other than the leading one and output-time information for the frames (PTS stands for Presentation Time Stamp, which indicates the time the picture is presented or output, "an index value to the block number of the block in which the I-picture is stored" corresponds to the recording-position information) separate the information from the I-frame for easy searching of whereabouts of records of data (e.g. Hyodo et al, column 3, lines 11-21).

Claims 1 and 4 are rejected for the same reasons as discussed in claim 2 above, wherein figure 2 of Okada et al shows encoder 105 to encode inputted video signal, ECC processor 102, column 5, lines 30-34 teach dividing information resulted from encoding of input content into access blocks each including a succession of frames.

For claims 3 and 5 are rejected for the same reasons as discussed in claim 2 above wherein Okada et al teach a reproducing apparatus for playing a recording medium having encoded content information recorded therein, the apparatus comprising:

a reading means for reading data recorded in the recording medium (e.g. figure 19, column 14, line 20- column 15, line 16, optical pick up 201);

a storage means for storing management information read from the recording mean(e.g. figure 19, column 14, line 20- column 15, line 16, track buffer 203);

a decoding means for decoding content information read from the recording medium and outputting content (e.g. figure 19, column 14, line 20- column 15, line 16, video decoder 205); and

a controlling means for controlling the reading and outputting of content information (e.g. figure 19, column 14, line 20- column 15, line 16, controller 211),

the controlling means functioning to: read recording-position information for each access block and output-time information for the leading frame of each access block, pre-recorded in the management area, before reading content information recorded in the data area and storing the recording-position information and output-time information into the storage means (e.g. figure 19, column 14, line 20- column 15, line 16, controller 211);

identify, for reproducing the leading frame of the access block, the recording position of the reading frame on the basis of recording-position information for the access block and output-time information for the leading frame of each access block, stored in the storage means (e.g. figure 19, column 14, line 20- column 15, line 16, controller 211); and

read, for reproducing a frame other than the leading frame of the access block, recording-position information and output-time information for the object frame from the data area of the recording medium on the basis of recording-position information for an access block including the object frame stored in the storage means to identify the recording position and output time of the object frame on the basis of the read recording-position information and output-time information (e.g. figure 19, column 14, line 20- column 15, line 16, controller 211).

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Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hirabayashi et al (US 6,308,003 B1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daquan Zhao whose telephone number is (571) 270-1119. The examiner can normally be reached on M-Fri. 7:30 -5, alt Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai Q, can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daquan Zhao/

Examiner, Art Unit 2621

/Thai Tran/

Supervisory Patent Examiner, Art Unit 2621